



Docket No.: 050352-0019

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 20277
: :
Tsuyoshi OKADA, et al. : Confirmation Number: 2515
: :
Application No.: 09/807,696 : Group Art Unit: 1764
: :
Filed: April 17, 2001 : Examiner: Nguyen, Tam M.
: :
For: GAS TURBINE FUEL OIL AND PRODUCTION METHOD THEREOF AND POWER
GENERATION METHOD

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a request for a pre-appeal conference to review the issues to be appealed to the Board of Patent Appeals and Interferences.

The single rejection in this application is a rejection of claims 1-17 and 20, all of the claims pending in the application, under 35 U.S.C. § 112, first paragraph. The rejection appears to be based on lack of enablement as opposed to inadequate written description since the Examiner is referring to undue experimentation. According to the Examiner, the specification provides insufficient guidance and direction to enable a person skilled in the art to practice the invention.

In Applicant's response to the last Office Action, the Applicant pointed out to the Examiner detailed information disclosed in the specification regarding examples of crude oil that can be

employed in the invention, distilling conditions, and temperatures and pressures in the hydrotreating units. The Examiner's attention was also directed to examples in the specification. The Examiner's response was that the arguments were insufficient. The Examiner based summarily stated that he "maintains that since the claims do not include any specific conditions required to produce the product and the specification does not disclose a combination of feed types, conditions and catalysts that can be used to produce the claimed product, one of ordinary skill in the art would have to perform a level of experimentation that is undue in order to perform the claimed invention to produce the claimed product." No other reasons were given in response to the details set forth in Applicant's response.

The Examiner's response is conclusionary and does not present any cogent scientific reasoning based on the prior art of record as to why the details set forth in Applicant's last response would not have provided a person having ordinary skill in the art with sufficient disclosure of the conditions to practice the invention. The types of crude oils are disclosed (feed types) and the temperatures and pressures for the distilling and hydrotreating conditions are disclosed. The types of catalysts that can be employed are any conventional catalysts used in hydrotreating conditions (see p. 15, lines 26-29 of the specification). The Examiner has not presented any evidence or basic scientific reasoning as to why a person skilled in the art could not practice the invention based on the disclosure in the specification. From the detail disclosed in the specification, such a person would have been able to practice the invention without any undue experimentation.

For all of the foregoing reasons, it is respectfully requested that the rejection under 35 U.S.C. 112, first paragraph, be reconsidered and withdrawn.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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